

REMARKS

Applicants thank the Examiner for the very thorough consideration given the present application.

Claims 1-3, 6 and 8-9 are now present in this application. Claims 1, 8 and 9 are independent. By this amendment, claims 1, 6, 8 and 9 are amended and claims 4 and 5 are canceled. No new matter is involved. Support for amendments to claims 1, 8 and 9 is found, for example, in paragraph [0066].

Reconsideration of this application, as amended, is respectfully requested.

Entry of Amendments

Independent claims 1, 8 and 9 are amended to incorporate the subject matter of claims 4 and 5 and their disclosed features, e.g., as disclosed in paragraphs [0065] and [0066] of the main body of the specification, therein. This subject matter has clearly been searched with respect to previously pending claims and, thus, this Amendment does not present issues that would require further reconsideration or search. Accordingly, it is proper to enter this Amendment.

Rejection Under 35 U.S.C. §§ 102 and 103

Claims 1-6 stand rejected under 35 U.S.C. § 102(b) as being anticipated by, or in the alternative under 35 U.S.C. § 103(a) as obvious over U.S. Patent No. 3,703,091 to Steele. This rejection is respectfully traversed.

A complete discussion of the Examiner's rejection is set forth in the Office Action, and is not being repeated here.

A prior art reference anticipates the subject matter of a claim when that reference discloses every feature of the claimed invention, either explicitly or inherently. In re Schreiber, 128 F.3d 1473, 1477, 44 USPQ2d 1429, 1431 (Fed. Cir. 1997) and Hazani v. Int'l Trade Comm'n, 126 F.3d 1473, 1477, 44 USPQ2d 1358, 1361 (Fed Cir. 1997). While, of course, it is possible that it is inherent in the operation of the prior art device that a particular element operates as theorized by the Examiner, inherency may not be established by probabilities or possibilities. What is inherent must necessarily be disclosed. In re Oelrich, 666 F.2d 578, 581, 212 USPQ 323, 326 (CCPA 1981) and In re Rijckaert, 9 F.3d 1531, 1534, 28 USPQ2d 1955, 1957 (Fed. Cir. 1993).

During patent examination the PTO bears the initial burden of presenting a *prima facie* case of unpatentability. In re Oetiker, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992); In re Piasecki, 745 F.2d 1468, 1472, 223 USPQ 785, 788 (Fed. Cir. 1984).

If the PTO fails to meet this burden, then the applicant is entitled to the patent. However, when a *prima facie* case is made, the burden shifts to the applicant to come forward with evidence and/or argument supporting patentability. Patentability *vel non* is then determined on the entirety of the record, by a preponderance of evidence and weight of argument.

Moreover, as stated in MPEP § 707.07(d), where a claim is refused for any reason relating to the merits thereof it should be "rejected" and the ground of rejection fully and clearly stated.

Additionally, findings of fact and conclusions of law by the USPTO must be made in accordance with the Administrative Procedure Act, 5 U.S.C. §706(A), (E) (1994). Zurko v. Dickinson, 527 U.S. 150, 158, 119 S.Ct. 1816, 1821, 50 USPQ2d 1930, 1934 (1999).

Applicants respectfully submit that Steele does not anticipate claim 1, as amended, because Steele does not disclose the combination of features positively recited in claim 1. For example,

Steele does not disclose (1) a tub provided in the cabinet with a front side and a rear side spaced therefrom to hold water and detergent therein; (2) a front spring connecting member located at an upper front end of the tub; (3) a rear spring connecting member spaced from the front spring connector and located at an upper rear end of the tub; (4) an elastic member over the tub to attenuate a front-to-rear vibration, and a vertical vibration, of the tub, wherein the elastic member includes a front spring having one end connected to the front spring connecting member and extending in an upper front direction and the other end connected to a lower front side of the top plate; and a rear spring having one end connected to the rear spring connecting member and extending in an upper rear direction and the other end connected to a lower rear side of the top plate; and (5) wherein the spring connecting members are installed at a middle portion between right and left sides over the tub, as recited in claims 1, 8 and 9.

Steele differs significantly from the claimed invention in that, for example, Steele discloses a single bracket 141 located midway from the front and back of the tub 11 to anchor springs 140. Moreover, Steele explicitly discloses that its resiliently mounted tub and drum assembly 11 “is supported within the casing substantially entirely from below by means of three so-called spring leg units,” wherein one of those three spring leg units has no damping facility (col. 3, lines 29-45). Steele also discloses, in col. 6, lines 1-33, that “a pair of relatively light stabilizing springs 140 are provided as shown in Fig. 2. These extend from a bracket 141 secured to the top of the assembly 11 centrally along its fore and aft length. The springs extend one forwards and one rearwards to suitable end connections 142 on the outer casing 10.” According to Steele, anchor springs 140 are “very light in nature and to all intents and purposes play no part in supporting the assembly 11 against downward movement.” This differs from Applicants’ invention, in which the elastic

member is specifically disclosed as attenuating the vertical vibration together with the damping unit, as well as attenuating the front-to-rear vibration of the tub – see paragraph [0066]. Claim 1 has been amended to positively recite this combination of features, which are clearly not disclosed or suggested by Steele. The features of claim 1 are also included in claims 2, 3 and 6, which depend from claim 1. These features are also recited in claims 8 and 9.

Furthermore, if a front-to-rear vibration is applied to Steele's tub, which employs only a single bracket 141 located over the tub 11, the tub is susceptible to rotating around the single bracket 141. In other words, Steele's single bracket 141 serves as a tub rotational axis. This single rotational axis structure of Steele's tub differs considerably from the positively claimed structure, which does not have a single rotational tub axis, but has two widely separated connection points at the top of the tub, to more effectively attenuate any front-to-rear vibration of the tub. This failure of Steele to provide the claimed structure is objective factual evidence that the claimed structure is not obvious based on Steele, who clearly failed to appreciate the improved front-to-rear vibration attenuation characteristics of Applicants' claimed structure.

Accordingly, Applicants respectfully submit that the Office Action does not make out a *prima facie* case of anticipation or of obviousness of claims 1-6 based on Steele.

Reconsideration and withdrawal of this rejection of claims 1-6 are respectfully requested.

Claims 1-6, 8 and 9 stand rejected under 35 USC § 103(a) as being unpatentable over U.S. Patent 6,826,932 to Sonoda et al. ("Sonoda") in view of either U.S. Patent 3,800,567 to Stelwagen or Steele. This rejection is respectfully traversed.

Because the rejection is based on 35 U.S.C. § 103, what is in issue in such a rejection is

"the invention as a whole", not just a few features of the claimed invention. Under 35 U.S.C. § 103, "[a] patent may not be obtained . . . if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains." The determination under section 103 is whether the claimed invention as a whole would have been obvious to a person of ordinary skill in the art at the time the invention was made. See In re O'Farrell, 853 F.2d 894, 902, 7 USPQ2d 1673, 1680 (Fed. Cir. 1988). In determining obviousness, the Examiner must explain what the differences between the claimed invention and the prior art are and provide objective factual evidence to support a conclusion that it would be obvious to one of ordinary skill in the art to achieve the claimed invention, which includes those missing features.

In the second place, in rejecting claims under 35 U.S.C. § 103, it is incumbent on the examiner to establish a factual basis to support the legal conclusion of obviousness. See, In re Fine, 837 F.2d 1071, 1073, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). In so doing, the examiner is expected to make the factual determinations set forth in Graham v. John Deere Co., 383 U.S. 1, 17, 148 USPQ 459, 467 (1966), and to provide a reason why one of ordinary skill in the pertinent art would have been led to modify the prior art or to combine prior art references to arrive at the claimed invention. Such reason must stem from some teaching, suggestion or implication in the prior art as a whole or knowledge generally available to one having ordinary skill in the art. Uniroyal Inc. v. F-Wiley Corp., 837 F.2d 1044, 1051, 5 USPQ2d 1434, 1438 (Fed. Cir. 1988), cert. denied, 488 U.S. 825 (1988); Ashland Oil, Inc. v. Delta Resins & Refractories, Inc., 776 F.2d 281, 293, 227 USPQ 657, 664 (Fed. Cir. 1985), cert. denied, 475 U.S. 1017 (1986); ACS

Hospital Systems, Inc. v. Montefiore Hospital, 732 F.2d 1572, 1577, 221 USPQ 929, 933 (Fed. Cir. 1984). These showings by the examiner are an essential part of complying with the burden of presenting a *prima facie* case of obviousness. Note, In re Oetiker, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992). The mere fact that the prior art may be modified in the manner suggested by the Examiner does not make the modification obvious unless the prior art suggested the desirability of the modification. In re Fritch, 972 F.2d 1260, 1266, 23 USPQ2d 1780, 1783-84 (Fed. Cir. 1992). To establish *prima facie* obviousness of a claimed invention, all the claim limitations must be suggested or taught by the prior art. In re Royka, 490 F.2d 981, 180 USPQ 580 (CCPA 1970). All words in a claim must be considered in judging the patentability of that claim against the prior art. In re Wilson, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970).

A showing of a suggestion, teaching, or motivation to combine the prior art references is an “essential evidentiary component of an obviousness holding.” C.R. Bard, Inc. v. M3 Sys. Inc., 157 F.3d 1340, 1352, 48 USPQ2d 1225, 1232 (Fed. Cir. 1998). This showing must be clear and particular, and broad conclusory statements about the teaching of multiple references, standing alone, are not “evidence.” See In re Dembiczak, 175 F.3d 994 at 1000, 50 USPQ2d 1614 at 1617 (Fed. Cir. 1999).

Moreover, a factual inquiry whether to modify a reference must be based on objective evidence of record, not merely conclusory statements of the Examiner. See, In re Lee, 277 F.3d 1338, 1343, 61 USPQ2d 1430, 1433 (Fed. Cir. 2002).

Applicants respectfully submit that Sonoda does not disclose or suggest the subject matter of independent claims 1, 8 and 9, as amended. For example, Sonoda does not disclose (1) a tub

provided in the cabinet with a front side and a rear side spaced therefrom to hold water and detergent therein; (2) a front spring connecting member located at an upper front end of the tub; (3) a rear spring connecting member spaced from the front spring connector and located at an upper rear end of the tub; and (4) an elastic member over the tub to attenuate a front-to-rear vibration, and vertical vibration, of the tub, wherein the elastic member includes a front spring having one end connected to the front spring connecting member and extending in an upper front direction and the other end connected to a lower front side of the top plate; and a rear spring having one end connected to the rear spring connecting member and extending in an upper rear direction and the other end connected to a lower rear side of the top plate, as recited.

Sonoda's springs 16, for example, do not comprise a front spring having one end connected to the front spring connecting member and extending in an upper front direction and the other end connected to a lower front side of the top plate; and a rear spring having one end connected to the rear spring connecting member and extending in an upper rear direction and the other end connected to a lower rear side of the top plate, as recited in claim 1.

Sonoda's springs are shown as having a horizontal axis and are connected to the front and rear side walls of the washing machine, instead of as claimed.

Additionally, Sonoda does not disclose that its springs are installed at a middle portion between right and left sides over the tub, either explicitly or inherently (i.e., necessarily). In this regard, reference to U.S. Patent 6,782,722 to Yokoi et al. ("Yokoi"), assigned to the same assignee to which Sonoda is assigned, which reveals upper springs (3L and 3R) that are not located in a middle portion of the drum. This is evidence that Sonoda does not explicitly or inherently (i.e., not just possibly or not just probably, but necessarily) disclose this middle portion location of the

claimed invention. A copy of Yokoi is enclosed for the Examiner's consideration.

To the extent that Steele is used to provide incentive to modify Sonoda to include locate the springs 16 in the middle portion of the top of the tub, Applicants respectfully submit that one of ordinary skill in the art would not have an incentive to do so because of the significantly different damper structures provided in Steele and in Sonoda, Steele having a specific three unit damper system, whereas Sonoda has a single damper 14. Steele provides no disclosure that its middle portion location, single bracket upper spring feature would work with Sonoda's significantly different single damper feature, which may result in significantly different vibration attenuation characteristics. Applicants respectfully submit that one of ordinary skill in the art would have no incentive to so radically redesign Sonoda based these significant differences in the damper structures of both devices. These differences are so significant as to teach away from the proposed modification of Sonoda in view of Steele.

Furthermore, Steele's structure results in a single rotational axis for its tub and this clearly is not an effective structure to attenuate front-to-rear vibration. This alone teaches away from motivating one of ordinary skill in the art to modify Sonoda in view of Steele.

Moreover, neither applied reference discloses that the upper springs, i.e., springs above the tub, attenuate vertical vibration. Steele's springs 140 admittedly do not do so and, because of the horizontal orientation of Sonoda's springs 16, it not seen how Sonoda's springs 16 accomplish this positively claimed feature. The Office Action does not present objective factual evidence to support a conclusion that the so modified version of Sonoda renders obvious this feature, either.

With respect to the proposed modification of Sonoda in view of Stelwagen, Stelwagen teaches away from modifying Sonoda's two springs to employ four springs and, even if one of

ordinary skill in the art were motivated to do so, the Office Action does not present objective factual evidence that the four springs would be located in the middle portion of the top pf the tub, as recited.

Accordingly, the Office Action does not make out a *prima facie* case of obviousness of the claimed invention based on Sonoda in view of Stelwagen or Steele.

Reconsideration and withdrawal of this rejection of claims 1-6, 8 and 9 are respectfully requested.

Claims 8-9 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Steele in view of Sonoda. This rejection is respectfully traversed. Complete discussions of the Examiner's rejection are set forth in the Office Action, and are not being repeated here. Claims 8 and 9, as amended, positively recite a combination of features that are not disclosed or suggested by the applied art. Steele's shortcomings with respect to the claimed invention are discussed above with respect to claim 1, which recites features similar to those recited in claims 8 and 9, as amended. Sonoda's shortcomings with respect to the claimed invention are also discussed above.

Neither Steele not Sonoda disclose or suggest an elastic member over the tub for attenuating both front-to-rear vibration and vertical vibration, and neither reference contains any suggestion for including such a feature in Steele. Moreover, Steele explicitly teaches away from providing such a feature in its device, for reasons discussed above, i.e., because Sonoda does not disclose that its springs are installed at a middle portion between right and left sides over the tub, either explicitly or inherently (i.e., necessarily).

In an attempt to justify the proposed modification of Steele in view of Sonoda, the Office Action asserts that it has been held that rearranging parts of an invention involves only routing skill in the art, citing In re Japikse, 86 USPQ76.

Applicants respectfully disagree with the statement of the holding in this case and assert that it is improperly applied to the facts at hand.

A reading of the “Japikse” case reveals that Japikse claimed a hydraulic power press. Claim 3 of Japikse allegedly read on the Cannon reference except for the feature, “means disposed in alignment with said opening for contact by said depending means to start the pressing operation of said hydraulic press.” The Board held that there would be no invention in shifting the starting switch disclosed by Cannon to a different position since the operation of the device would not thereby be modified (emphasis added). The Court found no error in that holding of the Board.

In the first place, Applicants respectfully submit that it is completely improper to base a rejection on the broad, general principle quoted above, which is incorrect in the sense that it does not address a rearrangement that affects the operation of the device, and is not clear and particular objective factual evidence which would motivate one of ordinary skill in the art to modify Steele to redesign and reconstruct Steele to provide the recited color order. See, in this regard, the aforementioned case law including, “In re Lee.” Moreover, this approach does not address the invention as a whole, as required by the decision in the previously cited “Graham v. John Deere” case. Evidence of this is in the language found in this case, which is eschewed by subsequent case law, i.e., “there is no invention in.” That is not the standard for evaluating obviousness of an invention under the subsequently enacted 1952 Patent Act.

Relying on such a statement is inconsistent with the principles set down by “Graham v. John Deere,” and “In re Lee,” and makes this rejection fundamentally improper.

Moreover, the reliance on the stated holding in this pre-1952 Patent Act case provides no objective evidence of the desire of one of ordinary skill in the art to redesign the disclosed structure of Steele in such a counter-intuitive manner.

Additionally, the Office Action fails to explain how this fundamental redesign of Steele, which deals with the operational aspects of Steele’s device, relates to locating a power switch for a hydraulic press that had no effect on the operation of the hydraulic device in issue in “Japikse.” Accordingly, this rejection must be based on improper speculation and/or impermissible hindsight.

Accordingly, it is respectfully submitted that this rejection fails to make out a *prima facie* case of obviousness of the invention recited in claims 8 and 9.

Reconsideration and withdrawal of this rejection of claims 8 and 9 are respectfully requested.

Conclusion

All of the stated grounds of rejection have been properly traversed, accommodated, or rendered moot. Applicants therefore respectfully request that the Examiner reconsider all presently outstanding rejections and that they be withdrawn. It is believed that a full and complete response has been made to the outstanding Office Action, and as such, the present application is in condition for allowance.

If the Examiner believes, for any reason, that personal communication will expedite prosecution of this application, the Examiner is invited to telephone Robert J. Webster, Registration No. 46, 472, at (703) 205-8000, in the Washington, D.C. area.

Prompt and favorable consideration of this Amendment is respectfully requested.

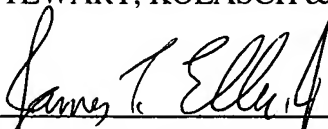
If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37 C.F.R. §§ 1.16 or 1.17; particularly, extension of time fees.


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Respectfully submitted,

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Attachment: Copy of U.S. Patent 6,782,722 to Yokoi